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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,163	06/28/2001	Robert A. Jerdonek	020967-000220US	7419
20350	7590	11/18/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			TRAN, ELLEN C	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/896,163

**Applicant(s)**

JERDONEK, ROBERT A.

**Examiner**

Ellen C Tran

**Art Unit**

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/18/02</u> . | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to communication: original application filed 28 June 2001, with acknowledgement of continuing filing date of 17 January 2001.
2. Claims 1-10 and 12-20 are currently pending in this application. Claims 1, 7, and 14 are independent claims. No claim 11 was present in application.
3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Although the invention is related to patent application, 09/895,560 Method for pre-authentication of users using one-time passwords", the claims in the invention do not use the term "one-time password" and are directed to an authentication system.

The following title is suggested: An authentication system utilizing challenges and public key cryptography.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-4, 6-10 and 12-17, and 20,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yatsukawa U.S. Patent No. 6,148,404 (hereinafter '404) in further view of Baskey et al. U.S. Patent No. 6,732,269 (hereinafter '269).

As to independent claim 1, **“A computer program product for a client computing system including a processor includes: code that directs the processor to request a challenge from an authentication server; code that directs the processor to receive the challenge from the authentication server”** and **“wherein the authentication server activates the identity code when the digital signature is verified, and wherein the codes reside on a tangible media”** is taught in ‘404 col. 12, lines 39-67 “the present invention provides an authentication terminal apparatus for granting authentication to an authentication request sent by an authentication requester via a storage medium, in support of an external authentication server, comprising: a main body; and means for accepting a storage medium storing: seed data used for generating authentication data to authenticate an authentication requester, a secret key of the authentication requester and a program for generating authentication data based on the seed data utilizing the secret key”;

**“the challenge comprising an identity code; code that directs the processor to receive user authentication data from a user; code that directs the processor to determine a private key and a digital certificate in response to the user authentication data; code that directs the processor to form a digital signature in response to the identity code and the private key; code that directs the processor to communicate the digital signature to the authentication server, code that directs the processor to communicate the digital certificate to the authentication server, the digital certificate comprising a public key in an encrypted form; and code that directs the processor to communicate network user authentication data and the identity code to the authentication server via a security server”** is shown in ‘404 col. 20, lines 11-31 “In the example shown in FIG. 16, it is a

precondition that the server obtains a public-key certificate of the client X at each log-in. In other words, the client sends the server, for instance, the public-key certificate CK.sub.px of the client X along with the authentication data. When the authentication processing program 104 at the server side receives a log-in message of a client X, the program 104 returns an authentication data request message to the client. When the program 14 receives authentication data transmitted by the client X in response to the message, the program 104 inspects a digital signature of the certification authority (CA), which is added to the public-key certificate of the client X, by utilizing a public key K.sub.pc (stored in the file 107) of the CA. If the inspection result shows that the digital signature is authentic, the program 104 verifies that the public-key certificate is the authentic public-key certificate of the client X. The public-key certificate CK.sub.px of the client X is stored in the inspection data file 105. The deciphering processing program 106 accesses the inspection data file 105 and derives the public key K.sub.px of the client X included in the public-key certificate CK.sub.px";

the following is not taught in '404 **"via a first secure communication channel"** however '269 teaches "" in col. 2, lines 21-40 "These and other objects of the present invention may be provided by methods, systems, and computer program products which communicate between client applications and a transaction server by establish a persistent secure connection between the transaction server and a Secure Socket Layer (SSL) proxy server";

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of '404 a method for authenticating users utilizing public/private key cryptography to include a means to utilize a secure socket layer. One of ordinary skill in the art would have been motivated to perform such a modification to because as network

communication improves a need exist to maintain with security communication standards available. As indicated by '269 (see col. 1, lines 13 et seq.) “ In communications between a client and a server, it is often beneficial to provide increased security. One mechanism for providing increased security is through the use of the Secure Socket Layer (SSL) protocol. FIG. 1 illustrates a conventional SSL connection between a client 10 and a server 12. As seen in FIG. 1, the client 10 communicates directly with the server 12 utilizing the SSL connection”.

As to dependent claim 2, **“wherein the identity code remains inactivate when the authentication server does not verify the digital signature”** is disclosed in '404 col. 20, lines 11-31.

As to dependent claim 3, **“wherein the security server comprises a server selected from the class firewall server, VPN gateway server”** is shown in '269 col. 5, lines 38-57 “other forms of secure connection may be utilized, such as, for example, a Virtual Private Network (VPN) tunnel, Internet Protocol Security (IPSEC)”.

As to dependent claim 4, **“wherein code that directs the processor to determine the private key and the digital certificate in response to the user authentication data comprises code that directs the processor to determine a private key associated with the user when the user authentication data is correct”** is disclosed in '404 col. 20, lines 11-31.

As to dependent claim 6, **“further comprising code that directs the processor to receive network user authentication data from the user”** is taught in '404 col. 12, lines 39-67.

As to dependent claim 7, **“wherein code that directs the processor to receive user authentication data from a user comprises code that directs the processor to receive user**

**authentication data and the network authentication data from the user”** is shown in ‘404 col. 12, lines 39-67.

As to independent claim 8, **“A client computing system for communicating with a private server includes: a tangible memory configured to store a key wallet”** is taught in ‘404 col. 12, lines 39-67

**“the key wallet including a private key associated with the user and a digital certificate associated with a user, the private key and digital certificate stored in an encrypted form; a processor coupled to the tangible memory, the processor configured to receive a challenge from an authentication server” and “the challenge comprising an identity code, configured to receive user authentication data from the user, configured to determine a retrieved private key and a retrieved digital certificate from the key wallet in response to the user authentication data from the user; configured to form a digital signature in response to the identity code and the retrieved private key, configured to communicate the digital signature to the authentication server, configured to communicate the digital certificate to the authentication server, and configured to communicate network user authentication data and the identity code to the authentication server via a security server, wherein the authentication server activates the identity code when the digital signature is verified, and wherein the security server allows the client computing system to communicate with the private server when the identity code is activated”** ” is shown in ‘404 col. 20, lines 11-31

the following is not taught in ‘404 **“via a first secure communication channel”** however ‘269 teaches “These and other objects of the present invention may be provided by methods,

systems, and computer program products which communicate between client applications and a transaction server by establish a persistent secure connection between the transaction server and a Secure Socket Layer (SSL) proxy server” in col. 2, lines 21-40.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of ‘404 a method for authenticating users utilizing public/private key cryptography to include a means to utilize a secure socket layer. One of ordinary skill in the art would have been motivated to perform such a modification to because as network communication improves a need exist to maintain with security communication standards available. As indicated by ‘269 (see col. 1, lines 13 et seq.) “ In communications between a client and a server, it is often beneficial to provide increased security. One mechanism for providing increased security is through the use of the Secure Socket Layer (SSL) protocol. FIG. 1 illustrates a conventional SSL connection between a client 10 and a server 12. As seen in FIG. 1, the client 10 communicates directly with the server 12 utilizing the SSL connection”.

**As to dependent claim 9, “wherein the retrieved private key and the private key associated with the user are identical”** is taught in ‘404 col. 11, lines 40-50 “the authenticator deciphers the received authentication data sent by the requester by using a public key of the authentication requester, and compares the deciphered data with inspection data ... inspecting whether or not they are coincident”.

**As to dependent claim 10, “wherein the retrieved private key and the private key associated with the user are different, and wherein when the retrieved private key and the private key associated with the user are different the identity code remains inactive”** is shown in ‘404 col. 18, lines 9-21 “Log-in is granted only when the deciphered data coincides



with inspection data which has been stored at the authenticator's side. Accordingly, as long as, a client securely keeps his/her own secret key, a third person who has any or all) of the authentication data ... is unable to "masquerade" as the authentic client".

**As to dependent claim 12, "wherein the security server comprises a server selected from the class firewall server, VPN gateway server, electronic mail server, web server, database server, database system, application server" is disclosed in '269 col. 5, lines 38-57.**

**As to dependent claim 13, "wherein the tangible memory can be removed from the client computer" is taught in '404 col. 20, lines 58-63 "Therefore, in the second modified example, the secret key  $K_s$  is stored in an IC card instead of the client terminal, enabling the client X to carry around the IC card".**

**As to dependent claim 14, "wherein the processor is also configured to receive the network user authentication data from the user" is shown in '404 col. 12, lines 39-67.**

**As to independent claim 15, this claim incorporates substantially similar subject matter as claims 1 and 8; therefore it is rejected along the same rationale.**

**As to dependent claim 16 and 17, these claims are substantially similar to claim 9 and 10; therefore they are rejected along the same rationale.**

**As to dependent claim 20, "wherein the client computing system is selected from the class desktop computer, portable computer, PDA, wireless device" is shown in '404 col. 21, lines 61-67 " More specifically, the system at the client side may be a general-purpose personal computer, and the personal computer may be used by persons other than the client X. In addition, any terminal can be used as the client's main apparatus as long as the terminal is**

capable of interfacing with an IC card. Accordingly, for instance, remote log-in or the like using a portable terminal is enabled from outside”.

6. **Claims 18 and 19**, are rejected under 35 U.S.C. 103(a) as being unpatentable over ‘404 in further view of ‘269 in further view of Chang et al. U.S. Patent No. 6,715,082 (hereinafter ‘082).

As to dependent claim 18, the following is not taught in the combination of ‘404 and ‘269: **“further comprising means for receiving at least a network password associated with the user from the user, wherein the means for communicating the digital certificate and the digital signature to the authentication server also comprise means for communicating the network password associated with the user to the authentication server”** however ‘082 teaches “A method and apparatus for validating access to a network system is disclosed ... In response to entering the username and one-time password, a user authorization phase is performed to determine whether a session should be established for the particular user” in col. 4, lines 10-43”.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of ‘404 and ‘269 a method for authenticating users utilizing public/private key cryptography with SSL to include a means to authenticate a network password. One of ordinary skill in the art would have been motivated to perform such a modification because many computer networks have a desire to provide remote access. As indicated by ‘082 (see col. 1, lines 17 et seq.) “A network system generally includes a number of network devices, such as switches, routers, and other connected so as to allow communication among the devices ... Many companies have a desire to provide remote access

to their computer networks. By allowing remote access, individuals can connect to the computer network to use it to work and obtain resource information while located at a remote site”.

As to dependent claim 19, **“wherein the means for communicating the digital certificate and the digital signature to the authentication server also comprise means for communicating a network password associated with the user to the authentication server; the client system further comprising means for determining the network password associated with the user in response to at least the PIN from the user”** is taught in ‘082 col. 4, lines 10-43”.

7. **Claim 5**, is rejected under 35 U.S.C. 103(a) as being unpatentable over ‘404 in further view of ‘269 in further view of Arthan et al. U.S. Patent No. 6,782,103 (hereinafter ‘103).

As to dependent claim 5, the following is not taught in ‘404 and ‘269 **“wherein code that directs the processor to determine the private key and the digital certificate in response to the user authentication data further comprises code that directs the processor to determine a private key not associated with the user when the user authentication data is incorrect”** however ‘103 teaches “If a key becomes compromised, then good cryptographic practice dictates that operational use of that key be suspended. The key then needs to be changed so that business can proceed using new uncompromised key” in col. 3, lines 9-17.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of ‘404 and ‘269 a method for authenticating users utilizing public/private key cryptography with SSL to include a means to change private key when authentication is incorrect. One of ordinary skill in the art would have been motivated to

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perform such a modification to because it is good practice to change keys when data becomes compromised. As indicated by '103 (see col. 1, lines 50 et seq.) "Good cryptographic practice requires all keys be changed at regular intervals, but if a key becomes compromised then it needs to be changed at other than the appropriate regular interval".

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ellen Tran  
Patent Examiner  
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03 November 2004



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